

### REMARKS

This responds to the Office Action mailed on March 31, 2004.

Claims 1, 6, 7, 13, 18, 21, and 27 are amended, no claims are canceled, and no claims are added; as a result, claims 1-30 are now pending in this application.

#### About the Claim Amendments

Applicant has amended independent claims 1, 13, 18 and 27 to further clarify the invention. Support for these amendments can be found in the Instant Application at Page 3, Lines 21-24; Page 4, Lines 18-19; and Page 10, Lines 2-4. Claims 6, 7, and 21 each depend, directly or indirectly, on one of dependent claims 1 or 18. Applicant has amended dependent claims 6, 7, and 21 to be consistent with the amendments made to independent claims 1 and 18.

#### §102 Rejection of the Claims

Claims 1, 2, 5-8, 10, 11, 13-19, 21, 22, 24, 25, 27, 28, and 30 were rejected under 35 USC § 102(b) as being anticipated by Wang et al. (U.S. Patent 5,832,296; hereinafter referred to as Wang).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that Wang does not teach each and every element of the amended claims.

Applicant has amended independent claim 1 to recite “wherein each of the plurality of sensors can be activated for positioning the pointer on the display screen.” (Emphasis added.) Applicant can find no passage in Wang that teaches or suggests this feature. Although Wang

teaches a single "two-dimensional force (or pressure) sensor," Wang does not teach or suggest the claimed "plurality of sensors... wherein each of the plurality of sensors can be activated for positioning the pointer on the display screen." (Emphasis added.)

Applicant has similarly amended independent claims 13, 18 and 27.

Claims 2, 5-8, 10, 11, 14-17, 19, 21, 22, 24, 25, 28, and 30 each depend, directly or indirectly, on one of amended independent claims 1, 13, 18, or 27. As such, Applicant respectfully submits that Wang does not teach or suggest each and every element of claims 1, 2, 5-8, 10, 11, 13-19, 21, 22, 24, 25, 27, 28, and 30.

#### §103 Rejection of the Claims

Claims 3, 4, and 20 were rejected under 35 USC § 103(a) as being unpatentable over Wang et al. in view of Eng et al. (U.S. Patent 5,638,092; hereinafter referred to as Eng). Applicant respectfully traverses this rejection because the Office Action has not established a *prima facie* case of obviousness regarding claims 3, 4, and 20.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Dependent claims 3, 4, and 20 include all the features of the claims from which they depend. Therefore, each of the rejected dependent claims includes a feature similar to "wherein each of the plurality of sensors can be activated for positioning the pointer on the display screen." As noted above, in the discussion of amended independent claim 1, Wang does not teach this feature. In order for the combination of Wang and Eng to teach the cited feature, Eng must teach what Wang is missing. However, Applicant can find no passage in Eng that teaches or suggests the claimed "wherein each of the plurality of sensors can be activated for positioning the pointer on the display screen." As such, Applicant respectfully submits that the combination of Wang and Eng does not teach each and every element of dependent claims 3, 4, and 20.

Claims 9, 12, 23, 26, and 29 were rejected under 35 USC § 103(a) as being unpatentable over Wang et al. in view of Russell (U.S. Patent 5,481,265; hereinafter referred to as Russell). Applicant respectfully traverses this rejection because the Office Action has not established a *prima facie* case of obviousness regarding claims 9, 12, 23, 26, and 29.

Dependent claims 9, 12, 23, 26, and 29 include all the features of the claims from which they depend. Therefore, each of the rejected dependent claims includes a feature similar to "wherein each of the plurality of sensors can be activated for positioning the pointer on the display screen." As noted above in the discussion of amended independent claim 1, Wang does not teach this feature. In order for the combination of Wang and Russell to teach the cited feature, Russell must teach what Wang is missing. However, Applicant can find no passage in Russell that teaches or suggests the claimed features noted above. As such, Applicant respectfully submits that the combination of Wang and Russell does not teach each and every element of dependent claims 9, 12, 23, 26, and 29.

Conclusion

Based on the foregoing, Applicant respectfully requests that the rejections be withdrawn. Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2169 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of June, 2004.

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